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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/638,429	08/12/2003	Kenichi Ariga	U2054.0143/P143	5082

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EXAMINER

TRINH, SONNY

ART UNIT	PAPER NUMBER
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2687

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/638,429

Applicant(s)

ARIGA, KENICHI

Examiner

Sonny TRINH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6 and 10-17 is/are rejected.
- 7) ☒ Claim(s) 2-4 and 7-9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 August 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/131,571.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 5, 6, 10-11, 15-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,625,455. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 5, 6, 10-11, 15-17 of the current application are encompassed by claim 1 of Patent Number 6,625,455.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. **Claims 1, 5, 15-17** are rejected under 35 U.S.C. 102(e) as being anticipated by Taguchi (hereinafter "Taguchi"; U.S. Patent number 6,052,577).

Regarding claim 1, with reference to figures 1, 3 and descriptions, Taguchi teaches a simple base station device (figure 1, communication prohibiting station 2, column 3 line 52 to column 4 line 4) installed in a boundary of an area prohibited from using a portable telephone set and used for outputting a display signal indicating said boundary (figure 1, column 2 lines 7-27); and a portable telephone set (figure 1 mobile station 3) having setting means for outputting, upon receiving said display signal when entering and alternatively exiting from said area, one selected from a communication suspension setting signal and a communication suspension release setting signal to a position management server in a radio network (column 2 lines 7-27, column 4), own portable

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telephone set having been position-registered in said position management server (column 4, specifically lines 26-36, figure 3).

Regarding **claim 5**, Taguchi further discloses that said setting means outputs an identifier included in said communication suspension setting signal to a telephone set that makes a call to a portable telephone set to be communication-suspended, said identifier indicating a service content provided to said telephone set (column 4, specifically lines 52-56).

Regarding **claim 15**, with reference to figure 1, Taguchi discloses an apparatus for controlling the operation of a portable communication device (figure 1, prohibiting station 2), the apparatus comprising: a simple base station for use in an area in which the use of the portable communication device is prohibited (figure 1, prohibiting station 2), the simple base station adapted to output a restricted use signal to the portable communication device (column 3 line 3 to column 4 line 20) and receive a communication status signal from the portable communication device in response to the restricted use signal (column 4, specifically lines 5-51).

Regarding **claim 16**, a position management server is inherently coupled to the simple base station, wherein the simple base station performs position-registration of the portable communication device in the position management server (column 4 lines 5-51).

Regarding **claim 16**, Taguchi further discloses that restricted use signal is a display signal indicating a boundary in which the use of the portable communication device is prohibited (column 4 lines 5-20).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 6, 10, 12-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Taguchi (hereinafter "Taguchi"; U.S. Patent number 6,052,577) in view of Neustein (hereinafter "Neustein"; U.S. Patent number 5,224,150).

Regarding **claim 6**, with reference to figures 1, 3 and descriptions, Taguchi teaches a portable telephone system (figure 1, station 2 inside area 10 is obviously portable) comprising: a simple base station device installed in an area prohibited from using a portable telephone set (figure 1, area 10) and used for outputting a signal instructing one selected from a limited and unlimited communication for a portable telephone set (see summary); and a portable telephone (figure 1, mobile station 3, figure 2) set having setting means for receiving, when entering and alternatively exiting from said area (abstract, column 2 lines 7-27), said instruction signal to perform a communication prohibited/suspension setting signal and alternatively a communication suspension release setting signal to a position management server in a radio network, own portable telephone set having been position-registered in said

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position management server (column 2 lines 7-27, column 4 line 5 to column 5 line 35).

However, Taguchi does not explicitly disclose that the instruction to the mobile station is one selected from power ON and power OFF.

In an analogous art, Neustein teaches an auditorium cutoff system that allows a local transmitter to disable the audio response of pagers within or entering into a local area (abstract, column 8 lines 17-22, claim 1).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to incorporate the instructions (ON/OFF), as taught by Neustein, into the system of Taguchi so that the system can be sure that the protected area is free of disturbance from portable devices.

Regarding **claim 10**, Taguchi further discloses that said setting means outputs an identifier included in said communication suspension setting signal to a telephone set that makes a call to a portable telephone set to be communication-suspended, said identifier indicating a service content provided to said telephone set (column 4, specifically lines 52-56).

Regarding **claim 12**, this claim is the corresponding method claim to the apparatus claim of claim 6 and is therefore rejected for the same reasons.

Regarding **claim 13**, Taguchi further teaches that the position management server controls call incoming to said portable telephone set based on position registration of said portable telephone set (column 4, specifically lines 22-56).

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Regarding **claim 14**, Taguchi further teaches that the method of claim 13, further comprising registering, when performing communication suspension setting, service content in said position management server, said service content being provided to a telephone set that makes a call to a portable telephone set to be communication-suspended, and providing, by said position management server, a service of said service content to a telephone set that has made a call to said portable telephone set (column 4 lines 22-56).

Allowable Subject Matter

4. **Claims 2-4, 7-9** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding **claims 2 and 7**, the applied references fail to disclose or render obvious the claimed limitations specifically wherein the simple base station device includes means for receiving one selected from said communication suspension setting signal and said communication suspension release setting signal and performing position-registration of said portable telephone set in said position management server via a public base station device.


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CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonny TRINH whose telephone number is 571-272-7927. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester KINCAID can be reached on 571-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SONNY TRINH
PRIMARY EXAMINER

9/8/05